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REMARKS

Claims 1-21 are currently pending in the subject application and are presently under consideration. Claims 1, 11 and 20 have been amended. Claims 2, 3 and 12 have been cancelled. A listing of all claims is at pages 2-5.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

**I. Rejection of Claims 1, 2, 4-11, 15, 16, 19 and 20 Under 35 U.S.C. §102(b)**

Claims 1, 2, 4-11, 15, 16, 19 and 20 stand rejected under 35 U.S.C. §102(b) as being anticipated by Electro-tech systems, Inc. (ETS) "Ground strap testers" (09/1997). This rejection should be withdrawn for at least the following reasons. ETS does not teach or suggest each and every limitation as recited in the subject claims.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989).

Independent claims 1, 11 and 20 have been amended herein to recite similar claim limitations, specifically *a light source with an illuminated condition (and non-illuminated condition) indicating an operating condition of the indicator apparatus*. These limitations were recited in dependent claims 2, 3 and 12. As conceded by the Examiner, ETS does not teach a light source having an illuminated condition (and a non-illuminated condition) being indicative of an operating condition of the indicator apparatus as claimed. In view of at least the foregoing, it is submitted that ETS does not teach, anticipate or suggest the invention as recited in independent claims 1, 11 and 20 (and claims 2, 4-10, 15, 16 and 19 which depend there from). Accordingly, this rejection should be withdrawn.

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**II. Rejection of Claims 3, 12, 13, 14, 17, and 18 Under 35 U.S.C. §103(a)**

Claims 3, 12, 13, 14, 17, and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over ETS. It is respectfully submitted that this rejection be withdrawn for at least the following reasons. ETS is not only non-analogous art but ETS does not teach or suggest each and every element of the claimed invention.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. See *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claims 3 and 12 have been cancelled and incorporated into independent claims 1 and 11. ETS discloses a Utility Wiring Verifier/ AC Outlet Tester (Model 256) ("Outlet Tester"). The Outlet Tester is a device providing the user information concerning the line wiring status, i.e., if the user wired the outlet correctly. In contrast, the present invention relates to an indicator apparatus with a recessed light source to mitigate damage when the apparatus is used in industrial environments. In addition, the light source has illuminated and non-illuminated conditions indicating operating conditions of the apparatus. Also, the present invention overcomes problems associated with indicators not being visible at different viewing angles by providing an indicator with improved visibility from multiple angles. (see Background and Summary, pages 1 and 2). Thus, there is no motivation and it would not have been obvious to one skilled in the art to modify the ETS reference to yield the subject invention.

Additionally, it is respectfully submitted that the Examiner has misinterpreted the cited reference. The Examiner states that since the Outlet Tester will illuminate and remain lit for as

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long as the TEST button is depressed, it would have been obvious to one of ordinary skill in the art to readily recognize that the Outlet Tester has an illuminated condition and a non-illuminated condition being indicative of an operating condition of the indicator apparatus. (ETS col. 1, lines 30-32). However, the portion of the document cited by the Examiner is referring to Group Strap Testers, not an Outlet Tester. The Outlet Tester provides a check of the wiring of an AC outlet and does not have a TEST button. In addition, the Outlet Tester does not have illuminated and non-illuminated conditions being indicative of an *operating condition of an indicator apparatus*. Rather, the Outlet Tester has lights corresponding to the wiring of a separate AC outlet. (ETS col 2, lines 25-27). Thus, ETS does not teach or suggest the subject invention.

In view of the foregoing comments, it is apparent that ETS is non-analogous art and in addition does not teach or suggest applicants' invention as recited in the subject claims. Therefore, rejection of claims 3 and 12 (now incorporated into independent claims 1 and 11, and claims 13, 14, 17, and 18 which depend there from) should be withdrawn.

### III. Rejection of Claim 21 Under 35 U.S.C. §103(a)

Claim 21 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Schneider *et al.* (U.S. D391,182) in view of ETS. It is submitted that this rejection should be withdrawn for at least the following reasons. ETS and Schneider *et al.* cannot be combined to make claim 21 obvious because there is not proper motivation in either reference to combine the reference teachings.

The Federal Circuit has consistently held that

*... 'virtually all [inventions] are combinations of old elements.'*

Therefore, an examiner may often find every element of a claimed invention in the prior art. *If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue.* Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. *Such an approach would be 'an illogical and inappropriate process by which to determine patentability.'* *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998) (citations omitted).

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The Federal Circuit requires the Examiner to show a motivation to combine the references to create the case of obviousness. That is, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. See *In re Rouffet, supra* at 1357.

As discussed *supra*, ETS is a utility wiring verifier that provides verification to determine if an outlet has been correctly wired. Schneider *et al.* discloses an ornamental design for a proximity sensor. Proximity sensors are used for detecting the presence or absence of an object, not to determine the wiring status of an AC outlet. In addition, the present invention relates to a proximity sensor system providing an indicator visible at different viewing angles as well as mitigating damage to a proximity sensor used in industrial environments by providing recessed light sources. Also, the present invention provides a light source that is illuminated *based on an operating condition of the proximity sensor system*. Thus, ETS does not refer to any problem that would suggest to one of ordinary skill in the art to use a proximity sensor in combination with an outlet wiring verifier. Likewise, the teachings of Schneider *et al.* would not suggest to one of ordinary skill in the art to use a proximity sensor in combination with the utility wiring verifier of ETS. Accordingly, withdrawal of this rejection is respectfully requested and allowance of claim 21 is earnestly solicited.

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**CONCLUSION**

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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